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Filed : November 6, 2001

### REMARKS

This paper amends Claims 1, 3 and 11, and adds new Claims 19-33. Claims 2, 4-10 and 12-18 are unchanged. Claims 1-33 are pending. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested.

The clarifications of the components of the database and their relationship in Claims 1 and 11, the text for the billing modifier module in Claim 1, and the text for the acts of Claim 11 were requested by the Examiner and are not intended to avoid prior art or to be narrowing. The clarification of Claim 3 also is not intended to avoid prior art or to be narrowing.

#### Examiner Interview

Applicant's representative wishes to express his appreciation for the Examiner's availability to conduct an interview on July 20, 2006, to discuss various matters related to the case. Applicant believes that substantial progress was made as a result of the interview, and believes that this amendment completely addresses the Examiner's concerns expressed therein.

#### Discussion of Claim Rejections under 35 USC § 103(a)

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being obvious over Clawson (U.S. Patent No. 6,106,459) in view of Barber et al. (U.S. Patent No. 4,858,121).

#### **Prima Facie Obviousness Requires a Teaching or Suggestion of All Claim Limitations**

M.P.E.P. § 2143.03 recites that all claim limitations must be taught or suggested. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

#### **Analysis**

The Clawson reference describes a computerized embodiment and a flip card deck embodiment for receiving and responding to emergency medical calls. The computerized embodiment includes a description that "a data base is accessed 504 to produce the appropriate instructions for communication with the caller". Similarly the flip card embodiment is accessed

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to produce the appropriate instructions for communication with the caller. Clawson further discloses at column 6, lines 58-60 that "Records of the calls and queries are stored 505, for historical reports, for review of the dispatchers and for continued quality assurance control". This sentence is the only mention of anything being stored in the Clawson reference. This sentence does not state that a medical emergency database stores at least clinical encounter information and transport information as in Applicant's claims. Clawson's record of the call and queries could be as simple as a log notebook entry having a date, time, and type of emergency inquiry (e.g., choking). The citations provided in the Office Action for the clinical encounter information (Clawson, col. 4, lines 2-5), (patient demographic data (col. 7, lines 25-31)), and transport information (col. 4, line 62 through col. 5, line 3) do not disclose that this information is stored in a medical emergency database. The cited text mentions that "the response configuration (emergency vehicles and the mode of response) is dispatched as indicated by the response protocol" and that the "responders" are "field emergency medical care-givers". However, the cited text does not state that the clinical encounter information and the medical transportation information for a particular clinical encounter are stored in the database. Furthermore, Applicant's Claim 1 (and similarly for Claim 11) recites, in pertinent part: "a medical emergency database configured to store at least clinical encounter information and transport information, wherein the transport information is associated with the clinical encounter information by at least including a location of a patient medical emergency". The cited text in Clawson does not disclose that the stored medical transport information is associated with the clinical encounter information by at least including a location of a patient medical emergency.

Applicant's Claim 1 (and similarly for Claim 11) further recites, in pertinent part: "a billing modifier module configured to access the clinical encounter location stored in the medical emergency database and configured to compare the clinical encounter location to a list of geographic areas". In Barber, patient and insurance company information is compared against zip code information. Neither the patient address nor the insurance company address is relevant to the clinical encounter location. However, the physician's office address, which the Examiner analogizes to the clinical encounter location, is merely compared against an existing address (to validate the physician's identification information). Therefore, the "comparison" feature is not disclosed in the cited references.

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Applicant's Claim 1 further recites in part: "a billing modifier module ... further configured so that the result of the comparison is used to determine at least one billing modifier to be applied to the medical charges associated with the medical emergency". The result of the comparison being used to determine at least one billing modifier to be applied to the medical charges is not disclosed in the cited references. Determining a billing modifier based on the comparison and applying the billing modifier to the medical charges as recited in Claim 11 is also not disclosed in the cited references.

Furthermore, the Office Action refers to Barber generating a "modified" or "partial" bill. Page 5, item 4(A) of the Office Action states "that the partial (i.e. modified) bill will only be generated once the physician's identity is validated (see rejection for claim 1), i.e. the generation of the bill is caused by the validation of the physician's identity." The portion of Barber that is pertinent to this statement in the Office Action is at column 3, line 67 to column 4, line 3 and recites: "For patients whose insurance contract only provides less than full compensation for the services provided, the central processing system B determines the balance due from the patient and notifies the remote terminal". However, Applicant's Claim 1 recites, in pertinent part "...further configured so that the result of the comparison is used to determine at least one billing modifier to be applied to the medical charges associated with the medical emergency". Therefore, any generating of a bill, much less modification of the bill, is irrelevant to the claims, as they refer to pre-bill activities.

### **Prima facie Obviousness Requires a Suggestion or Motivation and an Expectation of Success**

As stated in the Manual of Patent Examining Procedure 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

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the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

When an obviousness rejection is based on multiple prior art references, there must be a showing of a teaching, suggestion, or motivation to combine the references. Although the references need not expressly teach that their disclosures should be combined, the showing of combinability must be "clear and particular". *Winner Int'l Royalty Corp. v. Wang*, 2002 F.3d 1340, 1348-1349 (Fed Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999)). Motivation to combine requires desirability. *Id.*

As stated in the Manual of Patent Examining Procedure 2143.01, the fact that references can be combined or modified is not sufficient to establish prima facie obviousness. The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish prima facie obviousness.

### Analysis

There is no suggestion to combine the cited references since the alleged benefits of combining the references can all be met by the Barber reference. It does not appear that Clawson system, which describes a preferred embodiment of a flip card dispatch protocol, suggests the need for the Barber system, which describes a medical payment system having terminals in physician's offices. For example, Clawson can be used in a fire department system or a 911 system where no billing to insurance companies is done. The "motivations for this combination" of Clawson and Barber listed on page 4 of the Office Action are stated as:

- i) to verify the accuracy of billing information with respect to physician identity (Barber: col. 2, lines 3-6) and
- ii) to increase the speed of payment to physicians or other providers (Barber: col. 2, lines 32-36).

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These “motivations” are features of why one might want to buy the Barber system by itself (the features are performed by just the Barber system), but do not suggest why one of skill in the art at the time of the invention would want to combine Barber with Clawson. It is further not seen that such motive would inspire a person of ordinary skill in the art to combine the two references in such a way as to result in Applicant’s claimed invention.

Thus, Applicant respectfully submits that the Examiner has not met his prima facie burden to show where the suggestion to combine comes from, and has not presented a convincing line of reasoning, where the showing of combinability must be “clear and particular”.

#### Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Claims 2-10 and 12-27 are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

#### New Claims

New Claims 19-33 have been added. Claims 19-33 are supported at least by pages 6-12 of the specification and Figures 1-3.

#### Conclusion

In light of the above, reconsideration and withdrawal of the outstanding rejections are specifically requested. In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 10/16/06

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